REMARKS

Claims 1-32, all the claims pending in the application, stand rejected. The Examiner has repeated his original basis for rejection of the claims, notwithstanding Applicants' previous amendment to the claims that was intended to better define the subject matter of the present invention.

The detailed basis for the Examiner's rejection is again repeated at pages 3-14 of the Office Action. The Examiner's response to the Applicants' arguments in the previous amendment are presented at pages 14-18, and are organized on the basis of five basic arguments previously made by the Applicants. Applicants have addressed the Examiner's positions in the following analysis and respectfully submit that the claims should be considered patentable.

Claim Rejections - 35 U.S.C. § 102

Claims 11, 12, 23, 24, 27, 28, 31 and 32 are rejected under 35 U.S.C. § 102(e) as being anticipated by DeSimone et al (6,212,548). This rejection is traversed for at least the following reasons.

Applicants previously noted that the rejected claims are dividable into two groups. Applicants' analysis as to each group follows.

Claims 11, 23, 27 and 31

The claims of first group, comprising independent claims 11, 23, 27 and 31, concern a communication system, server device, communication method and computer readable recording medium that provides communication among a plurality of client devices that are connected to a server device through a network.

One key features of the invention in this group of claims include storage of a profile for each user <u>at the server device</u>. The profile comprises:

first identification information related to the network,
second identification related to the communication system, and

permit information related to approval or disapproval of use of a specific service by the user.

The claim also requires <u>at the server</u> a validation processing which extracts the permit information corresponding to the first identification information from the user's profile when (1) the first identification information and second identification information are presented from the client device along with (2) the requested for use of the specific service.

Finally, the claim requires that a judgment is made <u>at the server</u> as to whether the specific server should be provided on the basis of the permit information.

In Paragraph 20 of the Office Action, the Examiner repeats his assertion that the disclosure at col. 15, lines 20-36 of DeSimone clearly shows a first identification information ("message originators ID"), a second identification information (conversation ID), and permit information (pre-agreed security or interest criteria). The Examiner asserts that the permit information must be stored since it is "pre-agreed" and must correspond to the first identification information because, after satisfying the permit information, future received messages with the same conversation ID and originator ID are freely directed to the appropriate chat windows, with reference to col. 15, lines 37-40. As to the extraction step, the Examiner asserts that the information must be extracted or read from storage in order for DeSimone system to decide whether or not criteria are met. Finally, the Examiner points to the online chat between clients as being the claimed "specific service".

The flaw in the Examiner's analysis is that DeSimone places the pre-agreed security or interest criteria, as well as the processing for such criteria <u>in the receiving local clients</u>, as is clear from the disclosure at col. 15, lines 20-53. By contrast, the claimed features are resident in <u>the server</u> as expressly claimed. There is nothing in DeSimone that teaches or suggest that the structure or functions recited in rejected claims 11, 23, 27 and 31 would be located <u>at the server</u> <u>device</u>. **Thus, because of this difference, under basic principles of U.S. Patent Law, the claims cannot be anticipated by DeSimone.**

Claims 12, 24, 28 and 32

With regard to the group of claims represented by independent claims 12, 24, 28 and 32, the communication system again concerns a server device and a plurality of client devices connected through a network and allowing mutual communications among a plurality of users of the respective client devices. The server includes a profile storing unit which stores identification information preliminarily given to a user for identifying the user in the communication system and an arbitrary handle name of the user. The server also includes an ID converting unit which extracts the handle name corresponding to the identification information from the profile storing unit in the server when the identification information is presented from one client device and use of a specific service is requested. A conversion of the identification information is made based on the handle name.

At page 16 of the Office Action, the Examiner notes that DeSimone discloses a combination of sender's ID and a conversation index, which the Examiner asserts will meet the limitations of the claims as an arbitrary handle name ("sender's ID" which can be a nickname) and a communication system identification information ("unique conversation index"). The Examiner asserts that the system extracts handle names (or nicknames) corresponding to the identification information (conversation index) and converts identification information into a handle name, as claimed. The Examiner previously referred to the disclosure at col. 5, lines 40-54 with regard to the use of a nickname and the disclosure at col. 6, lines 57-64 for teaching of a conversion of identification information into a handle name.

The disclosure at col. 5, lines 40-54 does mention the use of a unique identifier, which may be a nickname, or participants in a conversation. The text states that the combination of sender's ID and conversation index are used by all recipients of a message to determine the conversation with which the message is associated. However, this portion of the specification does not have any teaching with respect to a server device that may have a profile storing unit or an ID converting unit. Indeed, given the clear intension of DeSimone to have control processing resident in the client devices rather than the server, there is no basis for the Examiner finding that the claim is anticipated. There is no teaching or suggestion that there is a storage of information

at the server identifying the user in the communication system and an arbitrary handle name of the user. Similarly there is no teaching of the structure that converts one to the other at the server. In this regard, it is clear from the teachings at col. 6, line 57 that all of the activity concerning conversion of identifiers occurs at the client device rather than at the server.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 6-9, 13-16, 18-21, 25, 26, 29 and 30 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over DeSimone et al (6,212,548) in view of Grimm et al (5,828,843). This rejection is traversed for at least the following reasons.

The rejected claims are also dividable into two groups of independent claims, which will be discussed separately.

Claims 1, 13, 25 and 29

Once again, the Examiner has repeated the basis for his rejection of these claims, notwithstanding the amendments to the claims in the previous Amendment. In the previous Amendment, Applicants argued that the present invention permits a user to be selected on the basis of an attribute reflecting a hobby, an occupation or the like, and a predetermined listing of acceptable designated users. The specification at pages 30-32 defines the use of a profile database which may be accessed by a unit 29 and may support use of user information, including a user ID password, communication ID and nickname of each user in the system profile of each user, friend information, rejection information and ban user list, all within the server device 1, as illustrated in Fig. 2.

As previously explained, the server includes a **matching unit**. The matching unit, not the client device, selects a candidate user for participation in a chat and transmits the information about the candidate user to a client device. The server also includes a check processing function for transmitting specified information for starting a chat when requested upon receipt of user identification information from another client. This participation is based upon a "specified standard" on the basis of which a selection is made.

The Examiner admits that DeSimone does not teach such specified criteria. The Examiner looks to Grimm et al for such teaching, on the basis of a generic disclosure of a match making system. In particular, the Examiner asserts that DeSimone's chat system uses a configuration involving terminals connected to one or more servers (col. 4, lines 4-18) and further asserts that Grimm's matchmaking process runs on a server (col. 2, lines 43-54) that is considered analogous to the server of DeSimone's system. The Examiner argues that the citation at col. 6, line 40-col. 8, line 57 shows the initiation of a chat when a server contacts designated recipients.

The Examiner observes that the recipients can be input by a client who wants to initiate the chat, as in the case of DeSimone or can be chosen by the server in a matchmaking process as taught in Grimm. The Examiner argues that DeSimone shows the initiation of a chat when a server contacts designated recipients (col. 6, line 40-col. 8, line 57) with the recipients input by a client who wants to initiate a chat. The Examiner observes that in the claims it seems as though the client may possibly input a candidate user selected by the matching unit for the initiation of a chat but finds this is not explicit. The Examiner concludes that, even if this was the intension, the combination would still disclose it as Grimm discloses selecting a candidate user based on a matchmaking process and DeSimone discloses the entering of recipients in order to initiate a chat session.

Once again, the claims in the first group simply calls for the server to implement a matching function by selecting a user for participation in the chat according to a specified standard. While each client device in the claimed invention has a user selecting unit for specifying at least a portion of a plurality of users, it is the matching unit in the server that selects a candidate user for participation in the chat according to a specified standard. In other words, a user selecting unit may identify a portion of the plurality of users to participate in the chat but it is the matching unit in the server that filters the selection of candidate users in accordance with some specified standard and only then transmits the information about the candidate user to a client device.

The Examiner relies upon a broad statement in the Abstract of Grimm et al that clients are selected based on attributes of their users, the clients, servers and/or communication links. However, Applicants respectfully submit that this is a broad statement that does not disclose the specific claimed features of the invention. Finally, Applicants respectfully submit that the transmission from the server device to a designated recipient client of the specified information for starting the chat on the basis of an input of specified users by a client device could not be applied in the DeSimone system because it relies upon activity at the client device, not the server, for selection and initiation of a chat.

Claims 6, 18, 26 and 30

With regard to the second group of independent claims (6, 18, 26 and 30), they concern a communication system comprising a server device and a plurality of client devices connected through a network where the server device has a matching unit which selects a candidate user on the basis of the content of the message according to a specified standard. Thus, it is the server which acts as a filter for selecting users on the basis of the content of a message, according to a specified standard. Applicants respectfully submit that nothing of this sort is found in the two references.

The Examiner responds at page 17 that the arguments in favor of rejection are similar to those given for claim 1. The Examiner asserts that Grimm at col. 2, lines 1-9 show that the system selects a candidate user for being matched in communication with another client. The Examiner asserts that specific examples of how the system matches users may found at Figs. 2-6 of Grimm, which show how attributes are checked and the flow of requests and replies between the client and the matchmaking server appear. The Examiner also points to DeSimone for a teaching of a processing unit which initiates a chat where a client device generates a message to be distributed to other clients by a server. In this case, DeSimone at col. 6 line 40-col. 8, line 57 does not teach that the server initiates the communication. In other words, there is no filtering function that occurs in DeSimone while the claim clearly requires that it is the server that provides the matching unit and the message processing unit. For forwarding a message content to the client device of a specified user when a request for message transmission is generated by

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one client device and <u>when the content of the message is specified</u>. Notably, at the <u>client device</u> the output unit issues an output when the <u>message content</u> is transmitted from the server device. This feature is not found in either Grimm or DeSimone.

Hindsight Reasoning

Finally, the Examiner asserts at pages 17 and 18 of the Office Action that the Applicant's argument with regard to the issue of obviousness based on hindsight reasoning is not convincing because the combination uses the fact that DeSimone's chat system uses a configuration involving terminals connected to one of more servers and Grimm' match making process runs on a server that can be considered analogous. The Examiner states that the motivation behind the combination was within the level of ordinary skill at the time the invention was made.

However, the Examiner's argument begs the question, as it assumes that the two references are pointed in the same direction as the Applicant's invention, namely, a server-controlled system where the decisions, filtering and connectivity is established at the server, not the client. <u>However, the very passages cited by the Examiner teach a completely opposite peer-to-peer system</u> where the server is a mere conduit or message forwarding node, as expressly stated at col. 15, lines 20-53, especially line 45. Such system does not use a server in the same manner as the claimed invention. Moreover, the server of DeSimone is not the same as in Grimm, as the latter is not peer-to-peer networked. Only hindsight would lead one skilled in the art to combine the two references and achieve what Applicant has first invented.

Finally, with regard to the previous arguments that mention the term "passive user", the Examiner observes that the term is not defined or referred to in the claims. Applicant has noted the phrase as a basis for indicating a fundamental difference in how the invention operates advantageously as compared to the prior art. The existence of passive users in the system is not essential to the invention, but it is relevant to understanding how the expressly claimed arrangements can be used advantageously.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Response Under 37 C.F.R. § 1.116
U.S. Application No. 09/777,680

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.
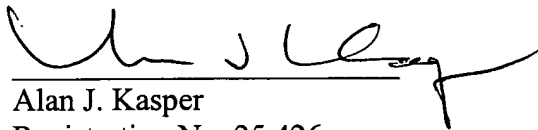
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